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***REMARKS***

This is a full and timely response to the outstanding Office action mailed December 28, 2005. Claims 1-3, 6-8, 15, and 21-42 are pending.

**I. Present Status of Patent Application**

The previous response is objected to as allegedly being non-responsive. In the previous Office Action, claims 1-3 were objected to for informalities. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Arnold (U.S. Patent No. 6,275,848) in view of Lafe (U.S. Patent No. 6,449,658). Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Beyda *et al.* (U.S. Patent No. 6,275,850) in view of Hanson *et al.* (U.S. Patent No. 6,549,957). These rejections are respectfully traversed.

**II. Examiner Interview**

Applicant first wishes to express sincere appreciation for the time that Examiner Neurauter spent with Applicant's representatives Jeff Kuester and Benjie Balser during an January 11, 2005 telephone discussion regarding the above-identified Office Action. Applicant believes that the responsiveness of the previous response was discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Neurauter indicated that it would be beneficial for Applicant to file this response. Thus, Applicant respectfully requests that Examiner Neurauter carefully consider this response.

**III. Rejections Under 35 U.S.C. §103(a) and Arnold****A. Claims 1-3, 6-8, and 15**

The Office Action rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

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**Independent claim 1 recites:**

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:
  - checking an electronic mail message against a predetermined criteria;
  - determining whether the message has been previously compressed; and***
  - compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.***

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable. For instance, the combination of the elements including checking an electronic mail message against a predetermined criteria; determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed is not disclosed in the cited references.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d

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1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

**B. Claims 21-23, 26-28, and 30-34**

The Office Action rejects claims 21-23, 26-28, and 30-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848 ) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21 recites:**

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

*performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and*

*compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns.*

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the

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combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable. For instance, the combination of the elements including performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns is not disclosed in the cited references.

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

The Office Action rejects claims 35-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

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**Independent claim 35 recites:**

35. A computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox on a computer comprising:

*logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and*

logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable. For instance, the combination of the elements including logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns is not disclosed in the cited references.

Because independent claim 35 is allowable over the cited art of record, dependent claims 36-42 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 recite further features and/or combinations of features, as are

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apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 are allowable.

#### IV. Rejections Under 35 U.S.C. §103(a) and *Beyda*

##### A. Claims 1-3, 6-8, and 15

The Office Action rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection.

##### **Independent claim 1 recites:**

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:  
*checking an electronic mail message against a predetermined criteria;  
determining whether the message has been previously compressed; and  
compacting a non-attachment portion of the electronic mail message if  
the predetermined criteria is satisfied and if the message has not been  
previously compressed.*

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons

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why claim 1 is allowable. For instance, the combination of the elements including checking an electronic mail message against a predetermined criteria; determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed is not disclosed in the cited references.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

**B. Claims 21-23, 26-28, and 30-34**

The Office Action rejects claims 21-23, 26-28, and 30-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21 recites:**

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

*performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and*

*compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the*

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electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable. For instance, the combination of the elements including performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns is not disclosed in the cited references.

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, and 30-34 are allowable.



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C. Claims 35-42

The Office Action rejects claims 35-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 35 recites:**

35. A computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox on a computer comprising:

*logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and*

*logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns.*

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable. For instance, the combination of the elements including logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns is not disclosed in the cited references.

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Because independent claim 35 is allowable over the cited art of record, dependent claims 36-42 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 are allowable.

**V. Miscellaneous Issues**

Claims 1-3 were objected to for informalities. Claim 1 was amended in the previous response by adding "automatically managing" in the preamble to overcome the objections to claims 1-3.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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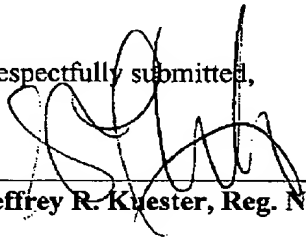
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**CONCLUSION**

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, that the response is fully responsive, and that the now pending claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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